

Appl. No. 09/996,338
Amdt. dated December 8, 2003
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

Claims 4-9, 11-13, 19 and 20 are pending.

Claims 4, 5, 9, 11 and 19 stand rejected under 35 U.S.C. 102(e) as being anticipated by International Business Machines Corporation (WO 02/05150).

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Takano et al. (USP 6,434,580).

Claims 6, 7, 12 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over IBM as applied to claim 19 and 5 and further in view of Takano et al.

Formal Matters

Applicants thank the Examiner for withdrawing the objections oath/declaration and for withdrawing the rejection under 35 U.S.C. Section 112.

The Rejection Under 35 U.S.C. 102(e)

Claims 4, 5, 9, 11 and 19 stand rejected under 35 U.S.C. 102(e) as being anticipated by International Business Machines Corporation (WO 02/05150). This rejection is traversed.

As an initial matter, Applicants note that the IBM WO 02/05150 PCT patent application (hereinafter "IBM PCT Application") is not prior art under 35 U.S.C. §102(e) to the present application. Section 102(e) allows international applications filed after Nov. 29, 2000 to be entitled to a 102(e)(1) date if the application was published in English and if it designated the United States. The IBM PCT Application was filed internationally on June 27, 2001 (after November 29, 2000) and was published in English. The IBM PCT Application did not, however, designate the United States. See field (81) on the first page, second column of the IBM PCT Application. Hence, the IBM PCT Application cannot be prior art under Section 102(e). For further clarification on this issue, the Examiner is encouraged to review MPEP Section 706.02(f)(1) and the flowchart on page 700-38.

Moreover, even if the IBM PCT Application was prior art under Section 102(e), Applicants note that it does not disclose all of the elements recited in independent claim 19 as argued by the Examiner. For example, the Rejection states that the IBM PCT Application

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discloses (i) allowing a plurality of different and unrelated technology developers to create a plurality of invention disclosures for each respective technology developer and store the disclosures in a database, (ii) storing invention disclosures in a database for a plurality of different technology developers and (iii) maintaining access rights so that client systems associated with one technology developer can access invention disclosure documents for that developer but not invention disclosure documents associated with a different unrelated technology developer. Applicants have reviewed that IBM PCT Application in detail including each of the sections and figures of the IBM PCT Application referenced by the Examiner for such disclosure and respectively disagree. Similar to the Eastman reference cited in the previous Office Action, the IBM PCT Application discloses a system and method for creating patent applications for a group of co-inventors that are associated with a single enterprise or company as opposed to different and unrelated technology developers as required by claim 19. Accordingly, for at least this reason, it can be appreciated that the IBM PCT Application, if it was prior art to the present application, does not anticipate claim 19 or any of claims 4, 5, 9 and 11 that depend from claim 19.

The Rejection Under 35 U.S.C. 103(a)

Claims 20 and 6, 7, 12 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Takano et al. (USP 6,434,580). This rejection is respectfully traversed because (1) the IBM PCT Application cannot be prior art under Section 102(e) as described above and (2) even if it was prior art, it does not teach or suggest the aspects of the claimed inventions that pertain to allowing the creation of, storing and security rights management of invention disclosures for different and unrelated technology developers as recited in claim 20 and the Takano et al reference, which is directed to a system for preparing patent applications for a single entity or company, does not make up for this deficiency in the IBM PCT Application. Accordingly, for at least these reasons, it can be appreciated that the IBM PCT Application, if it was prior art to the present application, cannot combine with Takano et al. to make any of claims 20, 6, 7, 12 and 13 obvious.

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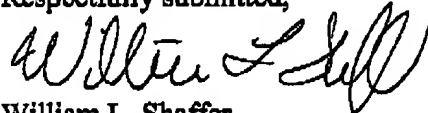
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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